

REMARKS

The above Amendments and these Remarks are in reply to the Office Action mailed 1 May 2008.

Claims 1-103 were pending in the Application prior to the outstanding Office Action.

The Examiner has rejected all of the claims under 35 U.S.C. §103(a) as being unpatentable in view of prior art, in particular, Christopher (US 6900980), Kaltenecker et al. (US 6816277), Jones (US 2002/0118949), Jeong et al. (US 6690878), Torres et al. (US 6738075), and Falcon (US 7222207).

Claims 1-103 remain pending. Reconsideration of the rejections is requested.

I. REJECTIONS UNDER 35 U.S.C. § 103(a)

The Examiner rejected claims 1-31, 38, 40, 42, 45-67, 74-85, 89, 92-103 under 35 U.S.C. 103(a) as being unpatentable over Christopher in view of Kaltenecker.

The Examiner also rejected all the other pending claims under 35 U.S.C. 103(a) as being unpatentable over Christopher, Kaltenecker, and either Jones, Jeong or Torres.

The independent claims are 1, 45, 74, 92, 93, 100, 102. These are all rejected over the combination of Christopher and Kaltenecker only. Applicants will address these claims first, followed by the dependent claims.

Applicants' invention, roughly described, covers a self contained, flexible, highly portable storage transfer and display system. that permits digital photographers and videographers to immediately share images with others by simply removing the device from the digital camera and viewing the stored set of images directly on the integrated display. See Figs. 7 and 10 of the subject patent application for visual examples.

In various aspects, the same device also performs the functions of a conventional removable memory device, and has a standard interface that allows bi-directional connections to a variety of different kinds of hosts at different times. In addition, the device also includes a controller which is operable to, among other things, determine automatically what image format is suitable for different hosts, and appropriately transform the image format in which an image is stored in the on-board memory. See Fig. 2 of the subject patent application for an example, where the portable memory device is the item designated 210.

The primary reference cited by the Examiner, Christopher, is entirely different. (The patent

appears to have been printed with an incorrect Fig. 1, so a copy of Fig. 1 as originally filed in Christopher has been obtained from PAIR and attached hereto for the convenience of the Examiner.) It can be seen that Christopher is an entirely conventional arrangement, with a desktop computer 114, a large CRT display 113 separate from and sitting on top of the computer 114, and a PDA cradle 120 connected to the computer via a cable 122. The Examiner considers all of these pieces to be part of the "portable memory device" called for in Applicants' claims. The Examiner also considers the "host" referred to in many of Applicants' claims to be satisfied by a PDA 130, an SD memory card 430, or a Multimedia card 432 that can be inserted into the cradle.

However, Christopher's "portable memory device" is certainly not "portable", as called for in many of Applicants' claims.

Nor are any of the "hosts" identified by the Examiner physically larger than Christopher's "portable memory device", as called for in many of Applicants' claims.

Nor does Christopher's system come anywhere close to the limitation in some of Applicants' claims calling for the "portable memory device" to be small like a PDA, fitting within a bounding box having specified dimensions.

Because Christopher is so far distant from Applicants' invention, it should not be surprising that distortions and omissions are necessary as the Examiner attempts to shoehorn the teachings of the reference into the stated limitations of Applicants' claims.

Applicants will now discuss Christopher as it relates to Applicants' individual independent claims.

A. Independent Claim 1

Claim 1 calls for, among other things:

1. A portable memory device comprising a substrate supporting:
a first memory;
a display;
a communications interface for establishing a user-severable communication link between the memory device and a plurality of different hosts at different times; and
a controller ...,

wherein the portable memory device fits within a bounding box having first and second parallel surfaces separated by no more than 10.5mm. (emphasis added)

Thus the claim calls for at least the memory, display and communications interface, all to be within a "portable" memory device, be supported by "a substrate", and fit within a bounding box having specified maximum dimensions.

The Examiner cites Christopher as teaching the above elements. As mentioned above, Christopher's patent appears to have been printed with an incorrect Fig. 1, so a copy of Fig. 1 as originally filed in Christopher has been obtained from PAIR and attached hereto for the convenience of the Examiner. Fig. 1 shows that Christopher's system is merely a conventional desktop computer with a PDA cradle connected via a cable.

The Examiner identifies Christopher's memory 414 and storage device 418 as constituting Applicants' "memory". In Christopher's Fig. 1 as originally filed, Applicants presume these items are part of the desktop computer box 114.

The Examiner also identifies Christopher's entire PC 410 as including Applicants' "display". As can be seen in the copy of Christopher's Fig. 1 as he originally filed it, his "display" is actually a conventional (and rather large) Cathode Ray Tube monitor separate from the desktop computer 114 and sitting on top of it.

The Examiner further identifies Christopher's cradle 420 as representing Applicants' "communications interface". As can be seen in Christopher's originally filed Fig. 1, the cradle is also separate from the desktop computer and attached to it via a cable 122.

So according to the Examiner's characterizations, the above three separate items of Christopher, two of which are large, heavy and awkward enough that it would be difficult for one person to lift them together, much less drop them in a shirt pocket to carry around, constitute the "portable memory device" called for in Applicants' claim.

Applicants' claim calls both for the "portable memory device" to be "portable", and to "fit within a bounding box" having a specified size. The Examiner cites no reference for these elements of the claim, but rather cites In re Rose, 105 USPQ 237 (CCPA 1955) for the proposition that "differences in degree and/or size and [are] not patentable distinctions" and that "the size of the article under consideration is not ordinarily a matter of invention".

First, the limitation that the memory device be "portable" is not a size limitation.
Christopher's computer system is clearly not "portable". Since the Examiner has failed to cite any

art teaching that a device having all the characteristics of Applicants' claim be "portable", the Examiner has failed to state a *prima facie* case that claim 1 is unpatentable. Applicants note that the word "portable" is used in both the preamble and body of the claim.

Second, the Examiner is not at liberty to ignore the size limitation. As pointed out in MPEP8 2143.02 (Rev.7), all claim limitations must be considered when judging the patentability of a claim against the prior art.

In re Rose is not to the contrary. A copy of In re Rose is attached hereto for the convenience of the Examiner, with the quoted language double-underlined (p.4).

It can be seen that the first of the Examiner's quotes from Rose, that "differences in degree and/or size and [are] not patentable distinctions", is part of the Board opinion that is merely quoted in the CCPA's opinion. The CCPA does not adopt that language, and the Examiner is incorrect to attribute it to the CCPA.

And the second of the Examiner's quotes, that "the size of the article under consideration is not ordinarily a matter of invention", does not authorize ignoring the a size limitation altogether. The inclusion of the word "ordinarily", in fact, actually invites analysis as to whether in a particular situation a size limitation is a matter of invention. In fact, the Rose court later does evaluate "invention", though only briefly and without the full rigor required today for an obviousness determination under the Supreme Court's ruling in *Graham v. John Deere & Co.* Applicants submit that if Rose had been decided after *Graham v. John Deere*, which was not decided until 1966, the quoted language of Rose would have been followed by the detailed obviousness analysis required by *Graham*.

Accordingly, Applicants submit that the fact that the limitation under consideration in Rose was one of size, would not have been sufficient by itself to affirm the rejection after *Graham v. John Deere & Co.*

Therefore, since the Examiner chose to ignore the size limitations of Applicants' claim, and failed to cite any art that teaches these limitations, the Examiner has failed to state a *prima facie* case that claim 1 is unpatentable for this reason as well.

Accordingly, Applicants respectfully submit that claim 1 should be patentable because the Examiner has failed to state a *prima facie* case of unpatentability.

B. Independent Claim 45

Claim 45 calls for, among other things:

A portable memory device comprising a substrate supporting:

- a memory;
- a display;
- a communications interface for establishing a user-severable communication link between the memory device and a plurality of different hosts at different times, at least one of the hosts being physically larger than the memory device;
- a mounting system for rigidly attaching the memory device to each of the hosts at different times; and
- a controller operable in response to user input

As with claim 1, the Examiner identifies Christopher's memory 414 and storage device 418 as constituting Applicants' "memory", his Cathode Ray Tube 113 as constituting Applicants' "display", and his cradle 420 as representing Applicants' "communications interface" and "mounting system".

The Examiner also identifies the following elements of Christopher as constituting the "plurality of different hosts" that can be "rigidly attached" to his cradle 420: "Handheld computer 440, SD card and Multimedia card 432 and other devices connectable to the PC via bus 412."

With respect to the "Handheld computer 440", the "SD card" and the "Multimedia card 432", however, **none of these "hosts" are "physically larger than" what the Examiner is calling the "memory device"**, i.e. the combination of Christopher's computer box, CRT and cradle. Nor is it *inherent* that any of the Examiner's supposed "other devices connectable to the PC via bus 412" would be "physically larger than" the combination of Christopher's computer box, CRT and cradle, especially since the claim also calls for such a host to be "rigidly attachable" to such combination via the mounting system.

Again, the Examiner attempts to bypass this limitation of claim 45 by citing *In re Rose* for the proposition that "differences in degree and/or size and [are] not patentable distinctions" and that "the size of the article under consideration is not ordinarily a matter of invention".

However, as pointed out above with respect to claim 1, the Examiner is not at liberty to ignore this size limitation.

Therefore, since the Examiner chose to ignore the size limitations of Applicants' claim, and failed to cite any art that teaches them, the Examiner has failed to state a *prima facie* case that claim 1 is unpatentable.

Accordingly, Applicants respectfully submit that claim 45 should be patentable because the Examiner has failed to state a *prima facie* case of unpatentability.

C. Independent Claim 74

Claim 74 calls for, among other things, a controller operable to "determine a second image file format suitable for a second one of the hosts".

The Examiner cites Kaltenecker col. 2, lines 28-61 as teaching this feature. However, nothing in the cited excerpt teaches any step of determining an image file format suitable "for a second one of the hosts".

Nor has the Examiner even pointed to which of the "hosts" that have been identified by the Examiner is to be considered the "second one of the hosts", nor pointed to anything in either Christopher or Kaltenecker that teaches that any image file format suitability restrictions might even exist for that host.

Accordingly, since the Examiner has not cited any reference that teaches a limitation of claim 74, it is respectfully submitted that the claim should be patentable for failure to state a *prima facie* case of unpatentability.

D. Independent Claim 92

Claim 92, like claim 1, calls for the portable memory device (1) to be portable, and (2) to "fit[] within a bounding box having first and second parallel surfaces separated by no more than 10.5mm".

Like claim 1, claim 92 should be patentable both because the Examiner has not cited any reference teaching a memory device that is "portable", nor any reference teaching the size limitation recited in the claim.

Accordingly, it is respectfully submitted that claim 92 should be patentable for failure to state a *prima facie* case of unpatentability.

E. Independent Claim 93

Claim 93 calls for, among other things, a step of:

while the first host is in communication with the memory device, capturing an image through the first host and into the memory of the memory device, the image being communicated to the memory device according to a first file format; ...

determining from the second host a second image file format suitable for the second host;

First, the Examiner has not identified any "first host" through which an image can be captured", as called for in the claim.

Second, the Examiner has not cited any reference which "determines from [a] second host a second image file format suitable for the second host." Kaltenecker does not teach this step, for at least the reasons set forth above with respect to claim 74.

Accordingly, since the Examiner has not cited any reference that teaches at least two limitations of claim 93, it is respectfully submitted that the claim should be patentable for failure to state a *prima facie* case of unpatentability.

F. Independent Claim 100

Claim 100 calls for, among other things, a portable memory device:

wherein the portable memory device fits within a bounding box having first and second parallel surfaces separated by no more than 10.5mm,

and wherein the display fills a major surface of the device.

Like claim 1, the Examiner has failed to cite any reference teaching a memory device that "fits within a bounding box having first and second parallel surfaces separated by no more than 10.5mm". As previously set forth, the Examiner is not at liberty to ignore this limitation.

Nor has the Examiner made any attempt at all to cite any teaching in either Christopher or Kaltenecker of a display which "fills a major surface of the device".

Accordingly, since the Examiner has not cited a reference that teaches either of the above two limitations of claim 100, it is respectfully submitted that the claim should be patentable for failure to state a *prima facie* case of unpatentability.

G. Independent Claim 102

Claim 102 calls for, among other things, a portable memory device:

wherein the portable memory device fits within a bounding box having first and second parallel surfaces separated by no more than 10.5mm, ...

and wherein the display fills said major surface except for a border no wider than 1/16 the size of said minor dimension.

Like claim 1, the Examiner has failed to cite any reference teaching a memory device that "fits within a bounding box having first and second parallel surfaces separated by no more than 10.5mm". As previously set forth, the Examiner is not at liberty to ignore this limitation.

Nor has the Examiner made any attempt at all to cite any teaching in either Christopher or Kaltenecker of a display which "fills [a] major surface except for a border" of specified maximum width.

Accordingly, since the Examiner has not cited a reference that teaches either of the above two limitations of claim 102, it is respectfully submitted that the claim should be patentable for failure to state a *prima facie* case of unpatentability.

H. Dependent Claims 2-44, 46-73, 75-91, 94-99, 101 and 103

The Examiner rejected these claims as being obvious over various combinations of Christopher, Kaltenecker, and either Jones, Jeong or Torres.

These claims all depend ultimately from one of the independent claims 1, 45, 74, 92, 93, 100, or 102, and therefore are believed to be patentable for at least the reasons set forth above with respect to the respective independent claim 1. In addition, these claims each add their own limitations which, it is submitted, render them patentable in their own right.

Applicants have reviewed the grounds for rejection of these claims as stated by the Examiner and respectfully do not agree with the positions taken. Nevertheless Applicants do not believe it necessary to discuss their views on these claims further, since the independent claims are believed patentable as set forth above. Applicants respectfully reserve the right to present their further points regarding these claims should it become necessary in the future.

Accordingly, claims 2-44, 46-73, 75-91, 94-99, 101 and 103 are believed to be patentable.

II. OTHER MATTERS AND CONCLUSION

The references cited by the Examiner but not relied upon have been reviewed, but are not believed to render the claims unpatentable, either singly or in combination.

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The fee for an appropriate Extension of Time is submitted with this Response.

Applicant believes no other fee is due with this response. However, the Commissioner is authorized to charge any fee or credit any overpayment related to the present submission to our Deposit Account No. 50-0869, under Order No. JMZ 1000-1US from which the undersigned is authorized to draw.

Dated: 26 September 2008

Respectfully submitted,

Electronic signature: /Warren S. Wolfeld/
Warren S. Wolfeld
Registration No.: 31,454
HAYNES BEFFEL & WOLFELD LLP
P.O. Box 366
637 Main Street
Half Moon Bay, California 94019
(650) 712-0340
Attorney for Applicant

ATTACHMENT TO RESPONSE A IN 10/663,183:

Fig. 1 of US 6900980 Christopher
1/4
as originally filed

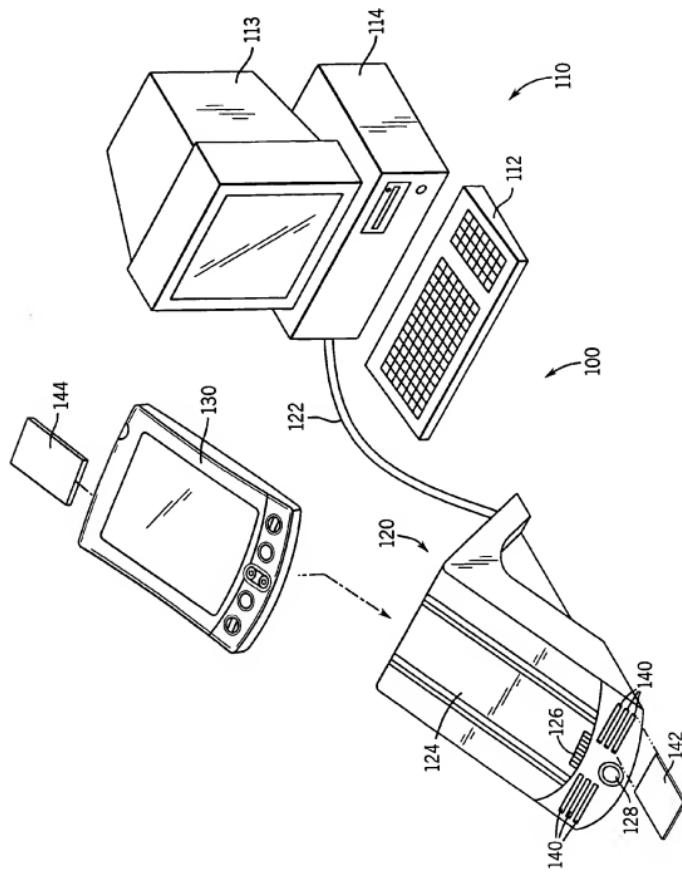


FIG. 1

102050-60524860